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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,525

01/16/2004

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949797-100029US

7039

34026

7590

09/18/2007

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EXAMINER

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ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

09/18/2007

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/759,525
Filing Date: January 16, 2004
Appellant(s): GOLDSMITH ET AL.

MAILED

SEP 18 2007

Group 3700

Lawrence R. LaPorte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/13/07 appealing from the Office action
mailed 5/9/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application Serial No. 10/439,652.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,407,195

Tiitola et al.

4-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 30-37, 40, 42-49, and 108-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christian '661 (Christian) in view of Tiitola. Christian discloses the claimed device with the exception of the use of a foam core blade as claimed. (Regarding lines 11-17 of claim 30 note Fig. 3 of Christian showing the permanent attachment of the composite blade to the wood hosel). Christian's blade has a wood core. However, as disclosed by Tiitola it is known in the art to use a foam core blade of the construction claimed. As Tiitola discloses, (Col. 1, lines 30-68) a blade or "paddle" such as he intends by his invention, is designed to be of better quality than known blades such as Christian's. Also, as disclosed at Col. 11, lines 55 and 56 of Tiitola, the handles for such composite blades may be made of wood or composite material. It would have been obvious to one of ordinary skill in the art to have used a foam core blade such as disclosed by Tiitola for Christian's blade to improve its quality.

Regarding the last two lines of claim 30, when a fiber composite blade such as Tiitola's is joined to the hosel in the manner disclosed by Christian the fibers of the blade necessarily have to be between the recessed heel section and the slot.

With regard to claim 43, Tiitola's fibers 44 where they occur in the bridges are non-continuous. Also Tiitola's claims are not limited to continuous strands and furthermore even were the strands continuous, removing the continuous nature of the

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strands with the corresponding loss of strength would have been obvious to one of ordinary skill in the art.

Concerning both claims 43 and 45, for one using a blade such as Tiitola's with a fastening system such as Christian's the bridge structures and fibers necessarily have to terminate at the recessed front and back side as well as the front and back side of the puck striking portion of blade. One of ordinary skill in the art using Tiitola's blade in a fastening system such as Christian's would obviously want to maintain the structural integrity of the blade throughout its length and would not remove the structural features within the portion of the blade being attached to the hosel.

Regarding claims 109 and 110, Christian only specifically discloses wood. However the examiner took official notice that the use of wood laminates to form wooden portions of hockey sticks is commonly known in the art to impart strength to the particular wooden part, and such is now admitted prior art. It would have been obvious to one of ordinary skill in the art to have done the same with Christian's wooden hosel for the same reason.

(10) Response to Argument

Appellant's first substantive argument concerning the rejection at hand appears on page 13 of the brief wherein it is argued that the limitation of a composite blade with a recessed heel has not been addressed. In response the examiner notes that on the contrary, this is the sole reason that the rejection is based on Christian in view of Tiitola under 35 U.S.C. 103(a), and not on Christian alone under 35 U.S.C. 102(b). As the examiner clearly pointed out and conceded in the rejection, Christian's blade is not of

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the type which includes a foam core. However, the inquiry does not stop at this point. Given that Christian does disclose a composite blade with a recessed heel permanently attached to a wooden hosel adapted for receipt within a tubular hockey stick shaft, it is necessary to consider whether the prior art considered as a whole would have obviated a construction such as Christian's wherein a blade with a foam core was used.

In considering the prior art as a whole, and specifically in considering Tiitola, it becomes clear that the prior art teaches that foam core blades are considered an improvement over wood core blades such as that disclosed by Christian. See again Col. 1 of Tiitola. Tiitola provides a specific teaching that blades such as his are intended to improve upon blades such as Christian's.

Thus, the ordinarily skilled artisan has been presented with the blade fastening being claimed (Christian), the type of blade being claimed (Tiitola) and a specific teaching in the references themselves to improve the blade of the Christian type with one of the Tiitola construction. As such the ordinarily skilled artisan would have had a strong motivation to combine the references which results in arrival at the appellant's claimed invention. Under 35 U.S.C. 103 therefore, the examiner cannot find the claimed blade to be patentable.

As to the limitation of requiring fibers between at least one recessed heel surface and the overlying inner surface of the slot, one must consider what would have been logical to the ordinarily skilled artisan providing Christian's blade as a foam cored blade as taught by Tiitola. As can be seen in Figs. 2-11 of Tiitola, a foam core blade comprises a structural sandwich of fiber reinforced plastic layers on the outside and

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foam on the inside. Obviously if one is to apply the teachings of Tiitola to Christian's blade, this means maintaining the structural integrity of the blade when it is constructed with a recessed heel. Therefore, when the heel of such a foam core blade is recessed in the manner taught by Christian, one of ordinary skill in the art would not simply slice off the fiber reinforced plastic layers to obtain the recess. This approach would clearly leave a structurally useless blade. To maintain the structural integrity of the blade therefore, it would obviously have been necessary to maintain the fiber reinforced outer layer in the recessed area of the blade. Thus, in constructing such a blade/shaft connection in accordance with the teachings of the prior art, one necessarily would have been providing fiber layers between "one or more of the recessed heel section surfaces and an overlying inner surface defining the slot" as claimed.

It should be remembered that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Appellant's second argument, beginning on page 15, starts by arguing the references individually for what they do not show rather than addressing them as a whole for what they do teach collectively. As is well known, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

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1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For the reasons explained above, considering Christian and Tiitola together rather than separately as argued by appellant indicates that the device claimed in claim 30 would have been obvious to the ordinarily skilled artisan.

Regarding the alleged non-teaching in the prior art of a hybrid hockey stick as argued beginning in the first full paragraph on page 16, nothing could be further from the truth. Christian plainly discloses a composite (fiber reinforced plastic and wood) blade in combination with a wood hosel (25, 26) and a tubular shaft 10. Further, Tiitola also discloses the use of his composite blade in combination with a wooden handle portion as well, at Col. 11, lines 52-56.

As to the amendments to claim 30 argued in the second full paragraph on page 16 of the brief, this argument has been addressed above. To repeat in summary however, it would have been obvious to one of ordinary skill in the art to have provided a blade such as Tiitola's with a recessed heel portion such that fibers were contained in the heel portion between a recessed surface and the slot to maintain the structural integrity of the blade. Otherwise the blade would obviously have been non-functional.

Appellant next addressed the rejections of claims 43 and 45.

Again with regard to claim 43, Tiitola's fibers 44 where they occur in the bridges are non-continuous. As Tiitola states at Col. 12, last paragraph they are strands (emphasis added) as opposed to fabric as is used in other embodiments. Also Tiitola's claims are not limited to continuous strands and furthermore even were the strands

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continuous, removing the continuous nature of the strands with the corresponding loss of strength would have been obvious to one of ordinary skill in the art.

Concerning the argument over both claims 43 and 45, again for one using a blade such as Tiitola's with a fastening system such as Christian's, the bridge structures and fibers necessarily have to terminate at the recessed front and back side as well as the front and back side of the puck striking portion of blade. One of ordinary skill in the art using Tiitola's blade in a fastening system such as Christian's would obviously want to maintain the structural integrity of the blade throughout its length and would not remove the structural features within the portion of the blade being attached to the hosel.

Regarding the claim 109 and 110 argument, it is admitted prior art that wooden laminates are known in the art. Such a construction provides strength. It would have been obvious to one of ordinary skill in the art to have done the same with Christian's wooden hosel for the same reason.

Appellant's final argument pertains to the 5/9/2006 declaration. The examiner has again reviewed the declaration and again finds no nexus between the commercial success alleged and the particularly claimed features of the hockey stick as set forth in the claims. The declaration refers only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

The weight attached to evidence of secondary considerations by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence. Note the great reliance apparently placed on this type of evidence by the Supreme Court in upholding the patent in *United States v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966). To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42, 227 USPQ 657, 673-674 n. 42 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). The term "nexus" designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Ltd.* 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988).

Paragraphs 34-39 of the declaration recited by the applicant on page 18 of the brief describe a desire to create a particular hockey stick and a general description of the blade/shaft connection in paragraph 39 which does not even include a number of

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the argued features of the device of claim 30, such as the limitation of the fiber layers between the recessed portion and the slot. Moreover, appellant has still failed to show that it is the particular features being claimed which contribute to the alleged commercial success. All that is being shown is that a hockey stick, having at least some of the features of the described device on it, has achieved a particular level of sales. There is no evidence connecting these sales to the features which the appellant is arguing are non-obvious in view of the prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

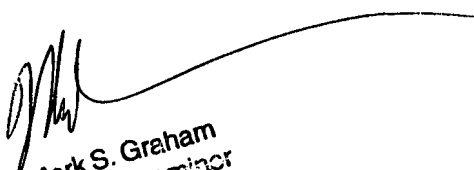
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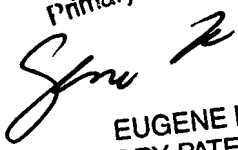
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